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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,036	11/23/2001	Michael D. Dahlin	1039-0040	4450
34456 7590 09/16/2009 LARSON NEWMAN & ABEL, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/92,036

Applicant(s)

DAHLLIN ET AL.

Examiner

Natalie A. Pass

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11, 16-20, 25-31, 40-44 and 51-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 16-20, 25-31, 40-44 and 51-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Notice to Applicant

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 July 2009 has been entered.
2. This communication is in response to the Request for Continued Examination and the amendment filed on 6 July 2009. Claims 1-8, 12-15, 21-24, 32-39, and 45-50 have been previously cancelled. Grounds of rejection for claims 9-11, 16-20, 25-31, 40-44 and 51-53 are set forth in detail below.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 9-11, 16-17, 27-31, 40-44, 51 and 53 are rejected under 35 U.S.C. §101.
 - A) As per claims 9-11, 16-17, 27-31, 40-44, 51 and 53, these appear to be directed toward a method or process for documenting medical findings of a physical examination. Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to

examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal Circuit decision since they are not required to be tied to another statutory class and can be performed without the use of a particular apparatus. In particular, Applicant's claims do not recite who or what is performing the method steps. Furthermore, the method steps fail to unambiguously require transformation of underlying subject matter to a different state or thing. The mere manipulation and production of non-functional descriptive material (i.e., "graphical interfaces") is not a transformation because a graphical interface is not statutory subject matter. Thus, claims 9 and 53 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

Dependent claims 10-11, 16-17, 27-31, 40-44, 51 merely add further details of the method recited in claim 9 without including any tie to another statutory category or any transformation of subject matter into a different state or thing. Thus, claims 10-11, 16-17, 27-31, 40-44, 51 are non-statutory since they are not requisitely tied to another statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9-11, 16-20, 25-31, 40-44, and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis et al., U.S. Patent Application Publication No. 2001/0041992 (it should be noted that the Examiner is relying on the priority date from the Lewis parent application 09/523,569; based on review of the parent application it is believed that the portions of the child application cited below are fully supported by the parent application), and Yoder, J. et al., The MEDIGATE Graphical User Interface for Entry of Physical Findings: Design Principles and Implementation. Journal of Medical Systems. Vol. 22, No. 5 / October, 1998, pages 325-337. URL: <<http://www.springerlink.com/content/g8504238744271h2/fulltext.pdf>>, hereinafter

known as Medigate, for substantially the same reasons given in the previous Office Action (paper number 20081230). Further reasons appear hereinbelow.

(A) As per claim 9, Lewis teaches a method for documenting medical findings of a physical examination, the method comprising:

displaying a first interface including a first graphical representation of anatomical features (Lewis; paragraph 0059);

accepting from a user a first selection of an anatomical feature based on the first graphical representation of anatomical features (Lewis; paragraph 0059);

displaying a second interface including a second graphical representation of anatomical features and a first set of controls relating to a first plurality of medical conditions in response to accepting the first selection (Lewis; paragraph 0061), the second graphical representation of anatomical features and the first set of controls displayed simultaneously without obstructing each other (Lewis; paragraph 0110 and Figure 4H, note that the controls relating to medical conditions such as 'SHOULDER SPRAIN', 'ROTATOR CUFF TEAR', etc. are simultaneously displayed but do not obstruct the graphical representation of anatomical features);

accepting from the user a second selection from the second graphical representation of anatomical features (Lewis; paragraph 0065); and

displaying a third interface including a second set of controls relating to a second plurality of medical conditions (Lewis; paragraph 0065).

Although Lewis teaches the second graphical representation of anatomical features and the first set of controls displayed simultaneously without obstructing each other (as discussed above), Lewis fails to explicitly disclose

without at least partially obstructing each other;

wherein the first set of controls includes a tri-state control configured to indicate present, not present, or not entered, the method further comprising:

accepting from the user an indication of not present, the indication resulting from the user selecting the tri-state control twice; and

storing data associating the indication with the first selection.

However, the above features are well-known in the art, as evidenced by Medigate.

In particular, Medigate teaches a method including

the second graphical representation of anatomical features and the first set of controls displayed simultaneously without at least partially obstructing each other (Medigate; Figure 2, page 332);

wherein the first set of controls includes a window containing check-boxes (reads on tri-state control") configured to indicate present, not present, or not entered (Medigate; Figure 1, Figure 2, page 330, paragraph 2, page 331, paragraph 2, paragraph bridging pages 331-332), the method further comprising:

accepting from the user an indication of "Normal" (reads on "not present"), the indication resulting from the user selecting the tri-state control twice (Medigate; page 330, paragraph 2,

paragraph bridging pages 331-332); Examiner notes that clicking on a check box multiple times inherently toggles the selection of the check box on and off; and

storing data associating the indication with the first selection (Medigate; paragraph bridging pages 331-332).

Examiner notes that although Medigate does not explicitly teach the first set of controls includes a tri-state control configured to indicate “present, not-present, or not entered,” this difference is only found in the non-functional data describing a control. The data identifying the control does not functionally relate to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to label the controls in Medigate in any desired manner since merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Moreover, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Lewis to include these limitations, as taught by Medigate, with the motivations of providing a means “to elucidate findings from the physical exam and to ... [...] ... implement an interface for the collection of these findings” with a “system ... [that is] ... rapid and easy to use, reduce[s] error ... [...] ... [provides] immediate

user feedback, and capture[s] quantitative and qualitative clinical data” (Medigate; page 326, paragraph 1).

(B) As per claims 10-11, Lewis and Medigate teach the method of claim 9 as described above, and further teach

the first graphical representation of anatomical features includes a graphical representation of a plurality of body locations (Lewis; paragraph 0059), (Medigate; Figure 1, page 330);

the first selection comprises a response indicative of one of the plurality of body locations (Lewis; paragraph 0059), (Medigate; Figure 2, page 332).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(C) As per claims 16-17, Lewis and Medigate teach the method of claim 9 as described above, and further teach

the step of displaying the first interface and the step of displaying the second interface take place in different views (Lewis; Figures 4A and 4B), (Medigate; Figure 1, page 330, Figure 2, page 332);

displaying the second interfaced comprises displaying the second graphical representation in response to the first selection by the user, the first selection indicating a portion of anatomical features associated with the first graphical representation to be displayed, the

second graphical representation including the portion of the anatomical features with greater detail (Lewis; paragraph 0061), (Medigate; Figure 1, page 330, Figure 2, page 332).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(D) Claims 18-20 and 25-26 recite substantially similar apparatus limitations to method claims 9-11 and 16-17 and, as such, are rejected for similar reasons as given above.

(E) As per claims 27-28, Lewis and Medigate teach the method of claim 9 as described above wherein

the second interface includes a drill down button (Lewis; paragraph 0007); and

the second interface includes a change system button (Lewis; paragraph 0064).

(F) As per claim 29, Lewis and Medigate teach the method of claim 28 as described above. Lewis further teaches displaying a list of systems associated with the first selection in response to a user selection of the change system button (Lewis; paragraph 0064).

(G) As per claim 30 Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second interface includes a procedure button (Lewis; paragraph 0063).

(H) As per claim 31, Lewis and Medigate teach the method of claim 30 as described above. Lewis further teaches displaying a list of procedures associated with the first selection in response to a user selection of the procedure button (Lewis; paragraph 0111).

(I) As per claims 40-43 Lewis and Medigate teach the method of claim 9 as described above wherein

the first set of controls includes an annotation control (Lewis; Figures 4A-4J);

the second plurality of medical conditions represents a greater level of detail than the first plurality of medical conditions (Lewis; paragraph 0065);

the second and third interface include a list of recent findings (Lewis; Figures 4A-4J);

displaying the first, second, and third interface are performed on a palm-top computer configured for use by a physician (Lewis; see paragraph 0033), (Medigate; paragraph bridging pages 333-334).

The motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

(J) As per claim 44, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches accepting from the user a third selection, the third selection including changing one control of the first set of controls (Lewis; paragraph 0048); and combining the first selection and the third selection to derive at least one medical finding (Lewis; paragraph 0048).

(K) As per claim 51, Lewis and Medigate teach the method of claim 9 as described above. Lewis further teaches the second graphical representation of anatomical features and the first set of controls are simultaneously active (Lewis; paragraph 0110 and Figure 4H).

(L) Claim 52 recites substantially similar apparatus limitations to method claim 51 and, as such, is rejected for similar reasons as given above.

(M) As per claim 53, Lewis and Medigate teach a method for documenting medical findings of a physical examination, the method comprising:

displaying a first interface including a first graphical representation of anatomical features (Lewis; paragraph 0059);

accepting from a user a first selection of an anatomical feature based on the first graphical representation of anatomical features (Lewis; paragraph 0059);

displaying a second interface including a second graphical representation of anatomical features and a first set of controls relating to a first plurality of medical conditions in response to accepting the first selection (Lewis; paragraph 0061), the second graphical representation of anatomical features and the first set of controls displayed simultaneously without obstructing each other (Lewis; paragraph 0110 and Figure 4H), (Medigate; Figure 2, page 332), wherein the second graphical representation of anatomical features and the first set of controls are simultaneously active (Lewis; paragraph 0110 and Figure 4H), wherein the first set of controls includes a window containing check-boxes (reads on tri-state control”) configured to indicate

present, not present, or not entered (Medigate; Figure 1, Figure 2, page 330, paragraph 2, page 331, paragraph 2, paragraph bridging pages 331-332);

accepting from the user an indication of “Normal” (reads on “not present”), the indication resulting from the user selecting the tri-state control twice (Medigate; page 330, paragraph 2, paragraph bridging pages 331-332); Examiner notes that clicking on a check box multiple times inherently toggles the selection of the check box on and off;

combining the first selection and the indication to derive at least one medical finding (Lewis Figures 4A-4J, paragraph 0048);

accepting from the user a second selection from the second graphical representation of anatomical features (Lewis; paragraph 0065); and

displaying a third interface including a second set of controls relating to a second plurality of medical conditions (Lewis; paragraph 0065).

Examiner notes that although Medigate does not explicitly teach the first set of controls includes a tri-state control configured to indicate “present, not-present, or not entered,” this difference is only found in the non-functional data describing a control. The data identifying the control does not functionally relate to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to label the controls in Medigate in

any desired manner since merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

The remaining motivations for combining the respective teachings of Lewis and Medigate are as given in the rejection of claim 9 above, and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 6 July 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 6 July 2009.

(A) As per Applicant's arguments on the page 7 of the response filed 6 July 2009 that neither Lewis nor Yoder [Examiner interprets 'Yoder' to refer to the Medigate reference] discloses a tri-state control, Examiner respectfully disagrees. Examiner interprets Medigate's teachings of windows with checkboxes that allow the physician to utilize the letter "N" to designate "Normal" and "P" to denote problem areas and "X" to designate a positive affirmation that all the findings were checked (Medigate; Figure 1, Figure 2, page 330, paragraph 2, page 331, paragraph 2, paragraph bridging pages 331-332) to teach a form of a "tri-state control."

As per Applicant's arguments in paragraph 2 on page 8 of the response filed 6 July 2009 that "the filing date of Lewis postdates the priority date of the present application" and that "the priority document of Lewis ... [...] ... is lacking much of the disclosure of Lewis ... [and] ... fails to teach or suggest many elements recited in the claims," Examiner respectfully disagrees. Firstly, Examiner notes that Applicant fails to specify precisely what features or "elements recited in the claims" are missing in the priority document of Lewis. Secondly, as per arguments relating to discrepancies between the applied Lewis reference and the parent application of the Lewis reference (09/523,569), Examiner notes that although the diagrams are not labeled identically to the applied Pre-Grant Publication, and although the diagrams are not identical, nevertheless Examiner interprets the subject matter, to teach Applicants limitations. For example, numerous figures, such as Figures 4A-4E of the parent application of Lewis show examples of a graphical interface which simultaneously displays a graphical representation of anatomical features (401, 410) and a set of controls (404, 412) relating to the plurality of medical conditions. In addition, descriptive text further elucidates the Lewis parent application (for example, see the Lewis parent application: page 4, lines 11-21, page 7, lines 24-30, page 15, lines 11-32, paragraph bridging pages 15-16, paragraph bridging pages 23-24, paragraph bridging pages 25-26, page 29, lines 3-21, and Figure 6 flow chart). Throughout the text, the parent application demonstrates interactively drilling down through anatomical features displayed on a user interface. Therefore, the Examiner respectfully disagrees with Applicants' interpretation of the teachings of the Lewis parent application, and interprets the Lewis reference to show teachings where applied. In addition, Examiner notes that it is the teachings of the

combined, applied art, Lewis and Medigate, that must be considered when evaluating the 35 USC § 103 rejections.

As per Applicant's arguments in pages 8-9 of the response filed 6 July 2009 that neither Lewis nor Yoder [Examiner interprets 'Yoder' to refer to the Medigate reference] discloses a tri-state control, Examiner respectfully notes that this argument has been addressed earlier in this Office Action.

Furthermore, Examiner notes that although Medigate does not explicitly teach the first set of controls includes a tri-state control configured to indicate "present, not-present, or not entered," this difference is only found in the non-functional data describing a control. The data identifying the control does not functionally relate to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to label the controls in Medigate in any desired manner since merely labeling the data differently from that in the prior art would have been obvious matter of design choice. *See In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

As per arguments in pages 8-9 of the response filed 6 July 2009 regarding selecting the tri-state control twice, Examiner notes that clicking on a check box multiple times inherently toggles the selection of the check box on and off.

As per Applicant's arguments in pages 9-10 of the response filed 6 July 2009, Examiner respectfully notes that these argument has been addressed earlier in this Office Action.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied articles teach the environment of documenting medical findings.

Yoder, J. The Role of Human-Computer Interaction in Medical Information Systems: Principles and Implementation of MEDIGATE. MS Thesis, University of Illinois at Urbana-Champaign, Department of Computer Science, 1992. [Retrieved from Internet 9/13/09]. URL: <<http://citeseerx.ist.psu.edu/viewdoc/download?doi=10.1.1.66.8039&rep=rep1&type=pdf>>.

Sanger, J. Graphic User Interface-Based Nuclear Medicine Reporting System. J Nucl Med 34: 515-522. 1992. [Retrieved from Internet 9/13/09]. URL: <<http://jnm.snmjournals.org/cgi/reprint/34/3/515.pdf>>.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label
“PROPOSED” or “DRAFT” on the front page of the
communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./

Examiner, Art Unit 3686

September 13, 2009

/Gerald J. O'Connor/

Supervisory Patent Examiner

Group Art Unit 3686